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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1943.

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**No.** .....

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S. DUKE, DOING BUSINESS UNDER THE NAME AND STYLE OF  
ROOSEVELT CHAIR & SUPPLY COMPANY,

*Petitioner,*

*vs.*

HERBERT A. EVEREST AND HARRY C. JENNINGS,

*Respondents.*

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**BRIEF IN SUPPORT OF PETITION.**

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**THE OPINIONS OF THE COURTS BELOW.**

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The Findings of Fact, Conclusions of Law and "Interlocutory Decree" of the District Court (R. 131 to 139, Inclusive) were carefully drawn by counsel for respondents so as to give the respondents, *by judicial construction* of the claims, an unwarranted monopoly upon the modern type of folding wheel chairs with complete disregard of express limitations in the claims. The decision of the Court of Appeals (R. 226 to 237, Inclusive) affirmed the decision of the District Court and further expanded the monopoly granted the respondents by disregarding all of the express limitations in the claims.

## ARGUMENT.

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### POINT I.

The great and growing demand for folding wheel chairs of the type here involved, especially for use by invalid members of the armed forces of the United States, would seem to warrant an immediate review by this Court of the basis of the patent monopoly in question because there is a so great need for such folding wheel chairs that other manufacturers in addition to the respondents should be permitted to supply them. Exceptional circumstances peculiarly affecting the public are sometimes deemed sufficient to warrant the granting of the right to examine the soundness of a decision of a Circuit Court of Appeals even in the absence of conflicting decisions as to the validity of the patent or patents involved. A few instances are

*American Fruit Growers, Inc. v. Brogdex Co.*, 283 U. S. 1.

*DeForest Radio Co. v. Gen. Elec. Co.*, 283 U. S. 664.

*Altoona Public Theatres v. American Tri-Ergon Corp.*, 294 U. S. 464, 477.

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211.

*Carbice Corp. v. Am. Patents Corp.*, 283 U. S. 27.

*Leitch Mfg. Co. v. Barber Co.*, 302 U. S. 458, 461.

*Muncie Gear Works v. Outboard, Marine & Mfg. Co.*, 315 U. S. 759, 62 S. Ct. 865.

*Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126.

*United Carbon Co. v. Binney & Smith Co.*, S. Ct. Law Ed. Advance Opinions, Vol. 87, page 158.

In the *Exhibit Supply Co. case, supra*, the Supreme Court said, at page 128:

“Although there is no conflict of decision, we were moved to grant the petition by the nature of the questions presented, together with a showing that the industry affected by the patent is located in the seventh circuit so that litigation in other circuits resulting in a conflict of decision would not be likely to occur.”

A comparable situation exists in this case. Respondents would obviously not risk the possibility of obtaining an adverse decision in another Circuit. If Respondents wished to litigate this patent again they would in all probability bring suit against a dealer or customer in the Seventh Circuit.

The power of this Court to grant a Writ of Certiorari is “coextensive with all possible necessities.” *Forsyth v. Hammond*, 166 U. S. 506.

## POINT II.

The Circuit Court of Appeals for the Seventh Circuit in upholding the patents in suit has decided a Federal question in a way probably in conflict with the applicable decisions of this Court and more particularly

*Cuno Engineering Corp. v. Automatic Devices Corp.*,

*Exhibit Supply Co. v. Ace Patents Corp.*,

*Schriber-Schroth Co. v. Cleveland Trust Co.*, (all *supra*).

The decision of the Court of Appeals in this case is not only in conflict with fundamental principles of Patent Law but operates, and will continue to operate, to the detriment of invalid members of the Armed Forces of the United States, as well as to the detriment of the public at

large. In so upholding the patents in suit the Court of Appeals has misapplied or refused to apply the applicable decisions of this Court. The patents in suit, especially when broadened by judicial decree, as here, are and will continue to be of great importance to the invalid members of the Armed Forces of the United States and to government hospitals and to the public at large.

The decision of the Circuit Court of Appeals for the Seventh Circuit is in conflict with the recent decisions of this Court setting forth the standard of what constitutes invention, and the flash of genius held necessary by this Court to constitute invention, as distinguished from mere mechanical skill. Certainly the provision of some looseness or "play" at appropriate points in the frames of the chairs which form the subject matter of the two patents here involved did not require inventive genius. On the contrary, no better example of what constitutes mere mechanical skill, as distinguished from invention, could possibly be given. And yet it is this looseness or "play" at the bottom of the arms of the X-brace, in the first patent, and at the center of the X-brace, in the second patent, which the Court of Appeals has found to represent inventive genius.

This Court in the case of *Cuno Engineering Corp. v. Automatic Devices Corp.*, *supra*, said:

"That is to say the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain."

Measured by this standard, the respondents, Everest and Jennings, made no invention because all that they did (if anything) was to put some looseness or "play" between relatively movable parts of the frames of the patent chairs, an obvious mechanical expedient, and merely mechanical skill as distinguished from invention.

## POINT III.

Neither the title of a patent, nor any part of the disclosure of the specification or drawings, may be read into a claim to save the claim from anticipation and invalidity. The Court of Appeals for the Seventh Circuit, in thus saving claim 1 of patent No. 2,095,411 from anticipation and invalidity, has clearly gone contrary to the law established by this Court and followed by other Circuit Courts of Appeals.

Thus, in the case of *McCarty v. Lehigh Valley Railroad Co.*, 160 U. S. 110, in holding patent No. 339,913 invalid, this Court said:

"There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are so described in the specification and exhibited in the drawings. *It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent.* While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, *we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement.* The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim and avoid a defense of anticipation, we should never know where to stop. If, for example, a prior device were produced exhibiting the combination of these claims plus the springs, the patentee might insist upon reading some other element into the claims, such, for instance, as the side frames and all other operative portions of the mechanism constituting the car truck, to prove that the prior device was not an anticipation. It might also require us to read into the fourth claim the flanges and pillars described in the third. This doctrine is too obviously untenable to require argument."

In the case of *Callison v. Pickens*, 77 F. (2) 62, the Court of Appeals for the Tenth Circuit had before it claim 1 of Callison patent No. 1,645,370. The claim was admittedly anticipated unless the words "coin controlled" were read into the claim to limit an element of the claim which called broadly for a "means." In holding the claim invalid the Court said at page 64:

"The question therefore narrows itself to an inquiry as to whether the 'means for lifting the stopping means \* \* \*' is coin controlled and therefore possesses novelty. The claim does not so provide. No reference is made in it to coin control of the stopping means. The specifications are relied upon to aid in sustaining the contention. A patent is enforced according to its claims. The purpose of specifications is to describe the invention so that one skilled in the art may make or use it. It is not the function of specifications to enlarge or contract the claims, but resort may be had to them for the purpose of interpreting the claims; that is, to ascertain the true intent of the parties at the time the claims were made and allowed. \* \* \* We therefore turn to the specifications for aid in interpreting the words 'means' and 'stopping means' as used in the claim.

\* \* \*

"Looking to the claim and the specifications to ascertain what appellant had in mind at the time those terms were used in the claim, it is perfectly clear that he referred exclusively to the bar superimposed on the top of the inclined surface which lifts to allow the balls to continue their way to the bottom of the plane and thence to the reloading device. The language used points with compelling persuasion to that conclusion. The claim provides that the balls shall be released 'by lifting the stopping means to release the balls,' manifestly referring to the bar, because nothing else is lifted. That view is reinforced by the fact that each of the other six claims specifically refers to the bar as the stopping means, and we fail to find anything in

the specifications or drawings accompanying them which indicates that the inventor intended to include in the means for stopping the balls anything other than the bar. *Under recognized rules, we cannot super-add coin control for the purpose of limiting the claim to avoid anticipation*, and, without coin control being included as a part of the stopping means, the patent is anticipated by the Young, Caille, MacKenzie, and Ellison patents, all earlier in time, because each of them accomplishes substantially the same thing in substantially the same way."

Other Courts of Appeals have followed this principle of patent law in the following cases:

*Frederick R. Stearns & Co. v. Russell*, 85 Fed. 218 (C. C. A. 6) (1898).

*Penfield v. C. & A. Potts & Co.*, 126 Fed. 475 (C. C. A. 6) (1903).

*General Subconstruction Co. v. Netcher*, 174 Fed. 236 (C. C. A. 7) (1909).

*Proudfit Loose Leaf Co. v. Kalamazoo Loose Leaf Binder Co.*, 230 Fed. 120 (C. C. A. 6) (1915).

Respectfully submitted,

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(All emphasis added.)

